



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| | | | | |
|--|-------------|----------------------|------------------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/555,654 | 11/04/2005 | Hiroyuki Kikkoji | 277186US6PCT | 2176 |
| 22850 | 7590 | 06/12/2008 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER HICKS, CHARLES N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2623 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 06/12/2008 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/555,654 | Applicant(s) KIKKOJI ET AL. | |
| | Examiner CHARLES N. HICKS | Art Unit 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/8/2006, 9/24/2007, 2/1/2006, 5/22/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff (US Patent No. 6,240,555 B1), hereinafter referred to as Shoff, in view of Tomsen (US 2002/0013950 A1), hereinafter referred to as Tomsen.

4. Regarding claim 1, Shoff discloses a data-processing apparatus configured to receive a broadcast signal and be connected to a network on which broadcast stations disclose content-related information related to broadcast contents, comprising: receiving means for receiving the broadcast signal of a prescribed frequency assigned to each of the broadcast stations (**fig. 2-5, col. 7, lines 50-68, col. 8, lines 1-18**);

reproducing means for reproducing the broadcast signal received by the receiving means (**fig. 2-5, col. 7, lines 50-68, col. 8, lines 1-18**);

communications control means for acquiring the content-related information through the network (**fig. 2-5, col. 7, lines 50-68, col. 8, lines 1-18**);

and display means for displaying predetermined information (**fig. 2-4, col. 4, lines 23-34**);

However Shoff fails to disclose setting means and control means. Tomsen discloses setting means for setting a frequency for the broadcast signal that can be received and for recording frequency information about the frequency set, in a predetermined recording medium (**fig. 1-3, pg. 3, paragraphs 26-27 wherein the merchant list are stored on ATVEF standard which are television frequencies**);

and control means for causing the display means to display a list of broadcast stations corresponding to at least one frequency set, in accordance with the frequency information set by the setting means, for acquiring the content-related information disclosed by the broadcast station selected from the list, and for causing the display means to display the content-related information (**fig. 1-3, pg. 2-3, paragraphs 25-28 and 31**). Motivation to combine the references is due to the fact that both references deal with matching selected programming with supplemental programming. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

5. Regarding claim 2, Shoff discloses the data-processing apparatus wherein the setting means records broadcast-station information containing broadcast station ID data identifying the broadcast station corresponding to the frequency and the name of the broadcast station, in association with the frequency information (**fig. 3, col. 6, lines 49-68**).

6. Regarding claim 3, Shoff discloses the data-processing apparatus wherein the control means is connected to the network, transmits the broadcast station ID data identifying the broadcast station selected by the communications control means, to an information-providing apparatus which provides information about a source of the content-related information distributed by the broadcast station, receives information about the broadcast station from the source, and collects the content-related information in accordance with the information about the source (**fig. 5-7, col. 8, lines 5-50**).

7. Regarding claim 4, Tomsen discloses the data-processing apparatus wherein the control means acquires information about a source of the content-related information distributed by all broadcast stations that correspond to the frequencies of broadcast signals which can be received, acquires the content-related information in accordance with the information about the source, and records the number-related information acquired, in the predetermined recording medium (**fig. 1-3, pg. 3, paragraphs 25-27**).

8. Regarding claim 5, Tomsen discloses a data-processing method for use in a data-processing apparatus configured to receive a broadcast signal and be connected to a network on which broadcast stations disclose content-related information related to broadcast contents, comprising the steps of: setting a frequency for any of the broadcast signal for the broadcast stations, which can be received, and recording frequency information about the frequency set, in a predetermined recording medium **(fig. 1-3, pg. 3, paragraph 26);**

displaying a list of broadcast stations corresponding to at least one frequency set, on predetermined display means, in accordance with the frequency information, while the broadcast signal selected is being received or not being received **(fig. 1-3, pg. 2-3, paragraphs 25-26);**

and acquiring content-related information disclosed by a broadcast station selected from the list displayed, through the network **(fig. 1-3, pg. 2-3, paragraphs 25-26).**

However Tomsen fails to disclose displaying the content-related information acquired, on the display means. Shoff discloses displaying the content-related information acquired, on the display means **(fig. 6-8, col. 10, lines 34-59).** Motivation to combine the references is due to the fact that both references deal with matching selected programming with supplemental programming. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

9. Regarding claim 8, Tomsen discloses a data-processing program for receiving broadcast signals and data processing by connecting to a network on which broadcast stations disclose content-related information related to broadcast contents, causing a computer to perform the steps of: setting the frequency of any one of the broadcast signals of predetermined frequencies, which can be received by the data-processing apparatus, and recording, in a prescribed recording medium, frequency information representing the frequency set (**fig. 1-3, pg. 3, paragraph 26**);

displaying a list of broadcast stations corresponding to at least one frequency set, on predetermined display means, in accordance with the frequency information, while the broadcast signal selected is being received or not being received (**fig. 1-3, pg. 2-3, paragraphs 25-26**);

and acquiring content-related information disclosed by a broadcast station selected from the list displayed, through the network (**fig. 1-3, pg. 2-3, paragraphs 25-26**).

However Tomsen fails to disclose displaying the content-related information acquired, on the display means. Shoff discloses displaying the content-related information acquired, on the display means (**fig. 6-8, col. 10, lines 34-59**). Motivation to combine the references is due to the fact that both references deal with matching selected programming with supplemental programming. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

10. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff, in view of Tomsen, in view of Hrastar (US 2008/0046951 A1), hereinafter referred to as Hrastar.

11. Regarding claim 6, Shoff discloses the data-processing method wherein: the data-processing apparatus is configured to communicate with an authentication server which has an authentication function and a related-information provision server which provides the content-related information (**fig. 3, col. 6, lines 49-68**);

and in the step of acquiring the related information through the network, the data-processing apparatus comprises the steps of: transmitting request information to the related-information provision server, together with a service-session ID for a session with the related-information provision server, said request information requesting for information related to the contents in a broadcast program being received (**fig. 5-7, col. 8, lines 5-50**);

transmitting request information for requesting for the related information, to the related-information provision server, together with the service-session ID received (**fig. 5-7, col. 8, lines 5-50**);

and receiving the related information which the related-information provision server transmits in response to the request information upon authenticating the data-processing apparatus (**fig. 2-5, col. 6, lines 10-35**).

However Shoff fails to disclose authentication. Hrastar discloses receiving information indicating an authentication error and service-identifying information

identifying the related-information provision server, from the related-information provision server **(fig. 2-3, pg. 3-4, paragraphs 37-38)**;

transmitting, to the authentication server, an authentication-ticket issuance request information requesting for issuance of an authentication ticket for accessing the related-information provision server, together with the authentication-session ID for a session with the authentication server **(fig. 2-4, pg. 4, paragraph 39)**;

receiving an authentication ticket issued from the authentication server when the authentication server authenticates the data-processing apparatus **(fig. 2-4, pg. 4, paragraphs 39-40)**;

transmitting authentication request information to the related-information provision server, together with the authentication ticket **(fig. 2-4, pg. 4, paragraph 39)**;

and receiving the service-session ID when the related-information provision server authenticates the data-processing apparatus **(fig. 2-4, pg. 4, paragraphs 39-41)**.

Motivation to combine the references is due to the fact they retrieve supplemental information based on characteristics of the originally requested information. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

12. Regarding claim 7, Hrastar discloses the data-processing method wherein the data-processing apparatus comprises the steps of: receiving information indicating an authentication error and transmitting an user ID and a password to the authentication

server, when the authentication server fails to authenticate the data-processing apparatus (**fig. 2-3, pg. 3-4, paragraphs 37-38**);

and receiving the authentication-session ID for a session with the authentication server, when the authentication server authenticates the user ID and the password (**fig. 2-4, pg. 4-5, paragraph 45**)

and transmitting the authentication ticket issuance request information to the authentication server, together with the authentication-session ID (**fig. 2-4, pg. 4, paragraph 39**).

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program requires computer readable memory as well as computer executable code to allow for functionality. This language does not fall into a statutory class.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tarbouriech (US Patent No. 6,650,877 B1) discloses a system for identifying data locations associated with real world observations. Incentis (US 2004/0133919 A1) discloses a system for enhancing television programs with

information on the World Wide Web. Pinder (US 2004/0237100 A1) discloses a system for validating client receivers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES N. HICKS whose telephone number is (571)270-3010. The examiner can normally be reached on M-F 7:30AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
Unit 2623

CNH

